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In the Supreme Court of the United States

October Term, 1940

No. 893

PAYNE FURNACE & SUPPLY CO., INC., a corporation,

Petitioner,

vs.

WILLIAMS-WALLACE COMPANY, a corporation.

On Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit

Brief for Respondent in Opposition to Petition for a Writ of Certiorari

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OPINIONS BELOW

No opinion was delivered by the District Court; its findings of fact and conclusions of law (R. Vol. I, 49-62) are unreported. The opinion of the Circuit Court of Appeals (R. Vol. IV, 922) is reported at 117 F. (2d) 823.

JURISDICTION

The judgment of the Circuit Court of Appeals was entered on February 14, 1941 (R. Vol. IV, 937). The petition

for a writ of certiorari was filed on March 27, 1941. The jurisdiction of this Court is invoked under section 240(a) of the Judicial Code, as amended by the Act of February 13, 1925.

STATEMENT OF THE CASE

This suit was brought by respondent in the District Court of the United States for the Northern District of California to enjoin, and to recover damages for, the infringement by petitioner of Letters Patent No. 2,013,193, covering an invention relating to composite flue pipe construction (R. Vol. I, 1-6). Petitioner conceded that its device is an infringement if the patent is valid (R. Vol. I, 82; Vol. IV, 922, 926). The District Court held the patent valid and infringed and ordered the cause referred to a Master for an accounting (R. Vol. I, 63).

On appeal petitioner repeated its contentions made in the District Court that the patent is invalid (a) for anticipation, and (b) because a disclaimer which was filed by respondent at the opening of the trial is defective. The Circuit Court of Appeals rejected both contentions and affirmed the decree of the District Court (R. Vol. IV, 937). Judge Mathews dissented (R. Vol. IV, 936).

With respect to anticipation, the Circuit Court of Appeals, after reviewing the prior art, held that the invention was novel; that it had overcome important difficulties in the field of flue pipe art and had received immediate and wide commercial adoption in the industry (R. Vol. IV, 926-928). Among other things, the Court pointed out that when petitioner manufactured and put on the market

an exact copy of respondent's device its advertising matter proclaimed as novel the features relied on by respondent as disclosing invention (R. Vol. IV, 926). With respect to the disclaimer, the Court held that it was a valid disclaimer which confined the original claims to the specific environment already fixed in the specifications and drawings, and which did not add any new element to the combination claimed in the original patent (R. Vol. IV, 928-936).

ARGUMENT

The Petition for Certiorari Should Be Denied. It Seeks Review Merely of Questions of Fact and the Construction of the Particular Patent Involved in This Suit. It Exhibits No Conflict of Decisions and No Such Conflict Exists.

Petitioner has abandoned its contention that the patent is invalid for anticipation. In the "Reasons Relied Upon for Allowance of Writ" (Pet., 11-12), and elsewhere in the petition and brief (pp. 4-5, 10, 16, 21, 32), petitioner states a large number of hypothetical questions of patent law, and asserts that these are questions which have not been settled by this Court and as to which "confusion" exists in the lower federal courts. Most of these questions are not involved in this case and are, therefore, purely academic.[1] With respect to this case, petitioner's only

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1. In passing we point out, however, that all of the hypothetical questions stated are answered by the following decisions of this Court:

Dunbar v. Myers (1876), 94 U. S. 187, 193, 194;
Minerals Separations v. Butte etc. Min'g Co. (1919), 250 U. S. 336, 354;

contentions are that the decision of the Circuit Court of Appeals is erroneous in that (a) the Court, in construing the claims of the patent, disregarded the disclaimer, filed by respondent, and (b) the Court, in construing the disclaimer, held that it did not add new elements to the original claims.

(a) The Circuit Court of Appeals did not disregard the disclaimer. On the contrary, the Court, in construing the patent claims, expressly gave the disclaimer full effect (R. Vol. IV, 933-935). Petitioner's argument is based upon a misconception of the meaning of the following language in the opinion (R. Vol. IV, 934, 935):

> "We are unable to read the disclaimer as attempting to do more than confine the claims to the specific environment already fixed in the specifications and drawings. By it the inventor undertakes to narrow the field of the claimed monopoly by introducing structural limitations taken directly from the specifications. * * *
>
> "Perhaps the general language of Stadtfeld's claims might have been thought so broad as to cover devices other than the one particularly described in the specifications, and this possibility suggests the reason for the disclaimer. The patentee appears to have been moved by the desire to disclaim any monop-

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Hailes v. Albany Stove Co. (1887), 123 U. S. 582, 586, 587;
Altoona Theatres v. American Tri-Ergon Corp. (1935), 294 U. S. 477, 490;
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oly in his composite pipe save when used for the purpose and assembled in the precise manner fully described in his specifications. We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed. But no one has been prejudiced by the disclaimer. An innocuous gesture of this sort ought not compel the penalizing of the inventor by striking down a meritorious invention. That course, we think, would pervert the benign purpose of the statute, converting it from a shield in the hands of the inventor to a sword in the possession of his adversary."

This ruling is in accord with numerous authorities.[2] The petition cites, and we know of, no decision to the contrary. There is, obviously, nothing in this language or any other language in the opinion which affords any basis for a contention that the Circuit Court of Appeals failed to give full effect to the disclaimer.

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2. Among these are:
Minerals Separations v. Butte etc. Min'g Co. (1919), 250 U. S. 336, 354;
Carnegie Steel Co. v. Cambria Iron Co. (1902), 185 U. S. 403, 436;
Smith v. Snow (1935), 294 U. S. 1, 13, 14;
Schriber Co. v. Cleveland Trust Co. (1940), 311 U. S. 211, 217;
Sessions v. Romadka (1892), 145 U. S. 29, 40;
Byrne Mfg. Co. v. American Flange & Mfg. Co. (6th C. C. A., 1937), 87 F. (2d) 783, 784 (Cert. denied 302 U. S. 699);
Metropolitan Device Corp. v. Cleveland E. Illuminating Co. (6th C. C. A., 1929), 36 F. (2d) 477;
N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co. (6th C. C. A., 1932), 56 F. (2d) 512, 513 (Cert. denied 287 U. S. 617);
Sachs v. Hartford Electric Supply Co. (2d C. C. A., 1931), 47 F. (2d) 743, 746, 747 (Cert. denied 283 U. S. 854).
See the many other authorities cited by the lower court (R. Vol. IV, 932).

(b) The question whether the disclaimer adds any elements to the original patent claims involves simply the application of settled principles of law to the particular patent here in suit.[3] This is demonstrated by petitioner's own argument at pages 22-32 of its brief, which substantially repeats its argument in the court below. The ruling by the District Court (R. Vol. I, 51), affirmed by the Circuit Court of Appeals, that the disclaimer added no new elements, is, we submit, clearly correct (see R. Vol. IV, 931-935). In any event, it turns upon the construction of the claims of this particular patent, as to which there is no conflict of decisions. The question, therefore, is not one which warrants the granting of a writ of certiorari.

Keller v. Adams-Campbell Co. (1924), 264 U. S. 314, 319.

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3. Petitioner says that the last three cases cited by this Court in footnote 3 of its opinion in *Altoona Theatres v. American Tri-Ergon Corp.* (1935), 294 U. S. 477, 490, do not support the text to which the cases are cited, and that this has created "confusion and uncertainty" as to what was decided in that case (Pet. 8-9, 12, 32). Contrary to petitioner's assertion, all three of these cases support the text to which they are cited. In *Minerals Separations v. Butte etc. Min'g Co.* (1919) 250 U. S. 336, the disclaimer changed the claim from one calling *generally* for "a small quantity of oil" to one for a *specific* quantity of oil "amounting to a fraction of 1 per cent on the ore." In *United Chromium, Inc. v. International Silver Co.* (2d C. C. A., 1932), 60 F. (2d) 913, the disclaimer qualified the claim so that instead of being *general* as to the proportions of certain ingredients, it was made *specific* as to these proportions throughout the process. In *Seiberling v. John E. Thropp's Sons Co.* (3d C. C. A., 1922), 284 Fed. 746, the disclaimer qualified the claim for a tire-making machine so that instead of being *general* as to where the fabric was applied and the speed at which it ran, it was made *specific* to apply the fabric only to the tread portion and the speed was specified as enough to throw the balance of the fabric outwardly until the spinning roll gradually forced it in against the side of the tire.

These decisions involved the same type of disclaimer as that involved in the present case and also in the many cases reviewed in the decision of the Circuit Court of Appeals (R. Vol. IV, 932).

CONCLUSION

This is an ordinary patent case in which petitioner is dissatisfied with the lower court's determination of the usual issues of invention and breadth of claims. There is no conflict of decisions. The petition, therefore, does not present a question which warrants issuance of a writ of certiorari and should be denied.

Respectfully submitted,

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